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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/578,568 | 05/05/2006 | Thomas Hasskerl | 287554US0PCT | 6924 |
| 22850 | 7590 | 09/10/2008 | | |
| OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | EXAMINER WALTERS JR, ROBERT S | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1792 | |
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| | | | 09/10/2008 | ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| | | | |
|------------------------------|---|--|--|
| Office Action Summary | Application No. 10/578,568 | Applicant(s) HASSKERL ET AL. | |
| | Examiner ROBERT S. WALTERS JR | Art Unit 1792 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/5/2006, 9/21/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Application

Claims 1-7 are pending and presented for examination.

Specification

The disclosure is objected to because of the following informalities: The disclosure requires the proper sections and section headings.

Appropriate correction is required.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

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- (I) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A “Sequence Listing” is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required “Sequence Listing” is not submitted as an electronic document on compact disc).

The use of several trademarks, for example PLEX and TEMPOL, has been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objections

Claims 1 and 6 are objected to because of the following informalities: Claim 1 is drawn to a lacquer system comprising elements a-f, wherein e is an electrically conductive metal oxide, a powder, a dispersion, etc. It appears this claim should read an electrically conductive metal oxide in the form of a powder or dispersion, etc. Claim 6 is objected to for the use of the abbreviations to denote the plastic. They should be referred to by their full names. Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined

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application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-7 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 and 10 of copending Application No. 10/548878 in view of Hino et al. (U.S. PG PUB No. 2003/0173545). Claims 1-7 and 10 of Application No. 10548878 teach all the features of pending claims 1-7 but is silent on the use of coated nanoparticles. Hino teaches the use of coated silica particles in an essentially identical lacquer composition (see 0028-0029 and Figs 1-2). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify copending Application No. 10/548878 to use a coated silica particle according to Hino to arrive at the invention of pending claims 1-7.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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2. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 is drawn to a thickener of polymeric thickeners at from 0-20% and oligomeric thickeners at from 0-40%. The claim is indefinite as it is unclear whether there is one thickener or if the thickener is actually a mixture of thickeners, which as claimed is not necessary since they can both be 0% based on the film components. For examination purposes the claim has been construed to be a thickener mixture having from 0-20% polymeric thickener and from 0-40% oligomeric thickener based on the dry film components and therefore, as both components can be 0%, a thickener is not required by the claims as written. Furthermore, based on the specification it is unclear how the binder is different from the thickener and it appears that the binder and thickener can be the same material. Therefore, appropriate clarification is required to render the claim definite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hino et al. (U.S. PG PUB No. 2003/0173545).

I. Regarding claims 1 and 4-7, Hino teaches a process for producing mouldings from plastics comprising coating a moulding, wherein the plastics moulding can comprise PC or PET or other plastics (0055), coated on one side with a lacquer system (the antistatic hard coat, see 0056-0057) and curing the lacquer system (0058). Hino further teaches the fabricated plastics moulding made by the process and the use of the moulding for displays (0142). Finally, Hino teaches that the lacquer system comprises:

- a) a binder (the polyfunctional acrylate, it should be noted that additional acrylates can be added to this binder which could serve as a thickener as well, see 0032-0035, 0049, and 0052);
- b) optionally a solvent (0048);

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- c) optionally other normal additives (0052);
- d) a thickener (it should be noted as above according to the claim interpretation a thickener is also optional, but Hino also teaches that other acrylates could be used as well as photo-curing agents and plasticizers, which would be comparable to a thickener (0032-0035, 0049, and 0052);
- e) an electrically conductive metal oxide (specifically indium tin oxide) as fine particles with a particle size of from 10-30 nm and from 50 to 400 parts based on the binder (0037-0039); and
- f) from 10 to 80 parts by weight based on the binder of coated (see 0028-0029 and Figs 1-2) inert silica particles (0041-0046).

Hino fails to explicitly teach a percentage of aggregation from 0.01-99% for the metal oxide particles and the silica particles being specifically nanoparticles. However, it would be obvious to one of ordinary skill in the art at the time of the invention that the oxide particles would have a degree of aggregation from 0.01-99% or in the alternative that the composition could be adjusted by one of ordinary skill in the art at the time of the invention through routine optimization to provide the metal oxide particles with a percentage of aggregation from 0.01-99%. Regarding the nanoparticles, Hino teaches a silica particle size of preferably from 0.1 to 3 microns (100-3000 nanometers, see 0042). It should be noted that nanoparticles are generally considered to be less than 100 nanometers. However, it would have been obvious to one of ordinary skill in the art at the time of the invention that a slightly smaller particle size, which would be considered a nanoparticle, could be used with a reasonable expectation of success and a predictable result. Furthermore, it would have been obvious to one of ordinary skill in the art at

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the time of the invention to choose the instantly claimed particle size range through process optimization, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

II. Regarding claims 2-3, Hino teaches all the elements required by claim 1, however is silent on the Brookfield viscosity. It would have been obvious to one of ordinary skill in the art at the time of the invention that the viscosity of the components a) to c) could be modulated by the amount of the components, especially the solvent component b) such that it could be adjusted over a broad range of viscosities. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to choose the instantly claimed ranges through process optimization, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

Conclusion

Claims 1-7 are pending.

Claims 1-7 are rejected.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT S. WALTERS JR whose telephone number is (571)270-5351. The examiner can normally be reached on Monday-Thursday, 6:30am to 5:00pm EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr can be reached on (571)272-1414. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ROBERT S. WALTERS JR/
September 5, 2008
Examiner, Art Unit 1792

/Michael Barr/
Supervisory Patent Examiner, Art Unit
1792
